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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/518,403	03/03/2000	Hisato Shima	SONY-C7751	7367

22850 7590 10/19/2005

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER
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ONUAKU, CHRISTOPHER O

ART UNIT	PAPER NUMBER
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2616

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/518,403

Applicant(s)

SHIMA ET AL.

Examiner

Christopher Onuaku

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 12-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

**NOTE:: 10/11/05**

1. This is a re-mailing of the Office Action originally mailed 7/1/05, because the wrong Office Action was inadvertently mailed 7/1/05. Furthermore, the period for response of three months set in said Office Action is restarted to begin with the date of this re-mailing of the Office Action.

IDS of 6/20/00

2. In the applicant's response received 4/1/05, applicant requested for the acknowledgement of an IDS of 6/20/00 forwarded by the applicant. The search of my records indicated that such IDS of 6/20/00 was not received by the PTO. It is noted that an IDS of 3/3/00 was received and acknowledged in the first Office Action mailed to the applicant on 2/2/04.

Applicant is advised to resend the applicant's referenced IDS of 6/20/00 for the examiner to review.

### ***Response to Arguments***

3. Applicant's arguments filed 4/1/05 have been fully considered but they are not persuasive.

Applicant argues that Park does not disclose or suggest the step of detecting whether the digital magnetic recording/reproducing system performs processing in compliance with copyright protection information as a prerequisite to receiving the digital signal.

In response, Park in processing copyright protection function uses a marker which is a copy prevention function information, marker detecting and inserting section 21 and marker analyzing and processing section 22. Input strips are supplied to marker analyzing/processing section 22 under the state that the marker is detected and decrypted in marker detecting/inserting section 21. Encrypted marker EM is decrypted by means of the encoding key in marker analyzing/processing section 22 to detect the control word. At this time, the recording can be performed or not in accordance with the result of the analysis. If the recording is not permitted, the detected control word is destructed to impede the reproduction even though the recording can be obtained. Otherwise, the current generation of the current generational field within the marker is augmented by one to update the marker, the encoding key is utilized to encrypt the marker, and the result is supplied to buffer section 23 (see Fig. 4; col.9, lines 8-28).

Furthermore, marker analyzing/processing section 22 has a marker decoder 33 for decrypting the encrypted marker from marker detector 31 of marker detecting/inserting section 21 by means of the encoding key, and a marker analyzer 34 analyzes the copy protection information within the marker from the marker decoder 33 to output control word to buffer section 23 when the copy is permitted while outputting a control signal for updating the marker.

Also, marker analyzer 34 compares the allowable generation of the allowable generational field for restricting the number of permitting the copy of the program with the current generation of the current generational field representing the current generation of the duplicated program to determine whether a copy is permitted or not. (col.9, line 63 to col.10, line 27).

From the above discussions, it can be seen that detecting the copy prevention function information, the marker, indicates that the copy prevention apparatus of Park embodies the copy prevention function.

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 12,14,15,16&21 are rejected under 35 U.S.C. 102(e) as being anticipated by Park ( US RE37,052).

Regarding claim 12, Park discloses a copy prevention method and apparatus of a digital recording/reproducing system wherein a marker involving copy prevention

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function information and executing the function is coded and inserted to perform the copy prevention function and realize the copy prevention function of various patterns desired by a program supplier, comprising the method steps of:

a) in a header information of a transmission frame of the digital signal to be transmitted, a copyright information is contained and the copyright information restricts recording of the digital signal to be inputted to the digital recording apparatus, wherein the copyright information comprises copy free information for indicating to the digital recording apparatus that the digital signal is copy free; and information for indicating to the digital recording apparatus to perform copy management in compliance with a copyright information included in the content of the transmitted transmission frame ( see the Fig.3; col.5, line 66 to col.7, line 67);

b) detecting copyright protection information provided in a transmission header of a transmission frame of a digital signal to be inputted to the digital recording apparatus, detecting whether the digital recording apparatus performs processing in compliance with the copyright protection information, and allowing the digital signal to be received by the digital recording apparatus in response to a detection that the digital recording apparatus performs processing in compliance with the copy protection information (see Fig.4&5; marker detecting and inserting section 21 and marker analyzing and processing section 22; col.9, line 50 to col.10, line 27)

Regarding claims 14&15, the claimed limitations of claims 14&15 are accommodated in the discussions of claim 1 above.

Regarding claim 16, the claimed limitations of claim 16 are accommodated in the discussions of claim 12 above, except for the claimed interface means ( see col.4, lines 32-41).

Regarding claim 21, the claimed limitations of claim 21 are accommodated in the discussions of claims 12&16 above, including the claimed "first" detector (see Fig.5, marker detector 31 of marker detecting and inserting section 21), and "second" detector (see Fig.5; marker analyzer 34 of marker analyzing and processing section 22), as discussed in claim 12 above.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 18-20&23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Park in view of Cloutier et al ( US 5,847,771), and further in view of Tamada et al (US 5,729,717).

Regarding claim 18, Park discloses the claimed limitations of claim 18 ( see claim 12 discussions, including the receiving means ( see col.8, lines 60-63), here the marker analyzing/processing section 22 of Fig.4&5 receives the input bit strips under the state that the marker is detected and encrypted in marker detecting/inserting section 21).

Park fails to explicitly disclose a digital interface. Cloutier et al, in the same field of endeavor, teaches bus interface 66 which is a high speed two way interface that supplies the primary program in MPEG2 format in parallel with ATM cell streams output from the ATM selector bank 64. The bus interface 66 operates in accordance with the published standard IEEE 1394 ( see Fig.3&4; and col. 10, lines 41-53). It would have been obvious to one of ordinary skill in the art to modify Park by realizing Park with a digital interface, as taught by Cloutier, which interface is based on IEEE 1394 standard and which interface provides a high speed interface.

Furthermore, Park fails to disclose a control IC. Tamada et al teach IC card and issuing apparatus which is a portable data storing/processing device connectable through a terminal device to a main data processing device comprising a portable main body, a memory of which memory area is segmented into a plurality of zones for storing data supplied to the main body, and an access controller for storing access condition for each zone of the memory to control the access to each zone. An IC chip is contained in a card 10 (see Fig. 1), a connector 12 is provided on the surface of the card, so that when the card 10 is inserted into a user terminal device, the connector 12 connects the IC chip with such a device. As shown in Fig.2, the IC chip includes a CPU 20, a zone access controller 22 which is an EEPROM and stores a password and an access



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condition for each zone of a memory 24 in the form of a zone access table ( see Table I in col.2), an encrypt circuit 26, an interface 28, and the memory 24 which is an EEPROM for storing a control program for the CPU 20. At the user terminal, after insertion of the IC card, a password is input by the card owner. It is sequentially checked whether or not each zone is accessible by the user terminal and the owner. Then, only the accessible zones are open to use by the owner ( see Fig. 1-5; and col.2, line 14 to col.4, line 45). Here, Tamada teaches the use of an IC to control the access to information and service which provides a portable data storing/processing device which is versatile in use to control access to information and service.

It would have been obvious to one of ordinary skill in the art to further modify Park by providing as an IC, as taught by Tamada, the copy protection device of Park, which would then make the Park device portable and versatile in use as a copy protection device.

Regarding claim 19, the claimed limitations of claim 19 are accommodated in the discussions of claims 12&18 above.

Regarding claim 20, the claimed limitations of claims 20 are accommodated in the discussions of claims 12&18 above.

Regarding claim 23, the claimed limitations of claim 23 are accommodated in the discussions of claim 18 above.

Regarding claim 24, the claimed limitations of claim 24 are accommodated in the discussions of claim 19 above.

Regarding claim 25, the claimed limitations of claim 25 are accommodated in the discussions of claim 20 above.

8. Claims 13,17&22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Park in view of Cloutier et al ( US 5,847,771).

Regarding claims 13,17&22, Park fails to disclose a digital interface based on IEEE 1394 format. Cloutier et al, in the same field of endeavor, teaches bus interface 66 which is a high speed two way interface that supplies the primary program in MPEG2 format in parallel with ATM cell streams output from the ATM selector bank 64. The bus interface 66 operates in accordance with the published standard IEEE 1394 ( see Fig.3&4; and col. 10, lines 41-53). It would have been obvious to one of ordinary skill in the art to modify Park by realizing Park with a digital interface, as taught by Cloutier, which interface is based on IEEE 1394 standard and which interface provides a high speed interface.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from this examiner should be directed to Christopher Onuaku whose telephone number is (703) 308-7555. The examiner can normally be reached on Tuesday to Thursday from 7:30 am to 5:00 pm. The examiner can also be reached on alternate Monday.

If attempts to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Andrew Faile, can be reached on (703) 305-4380.

#### **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

#### **or faxed to:**

(703) 872-9314, (for formal communications intended for entry)

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and (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be direct to the Group receptionist whose telephone is (703) 306-0377.

  
COO

6/22/05.

  
James J. Groody  
Supervisory Patent Examiner  
Art Unit 262 2616